

REMARKS

Claims 1-8 and 11 are pending and stand ready for further action on the merits. Support for the amendment to claim 1 can be found in claim 9. Claim 5 has been amended so as to be more limited in scope than claim 1, the claim from which claim 5 depends. Support for new claim 11 can be found in the paragraph bridging pages 8 and 9 of the specification. No new matter has been added by way of the above-amendment.

Statz, U.S. 5,889,114

Claims 1-4 and 6 are rejected under 35 U.S.C. §102(b) as being anticipated by Statz. Applicants respectfully traverse the rejection.

Applicants respectfully submit that Statz fails to anticipate the presently claimed invention; however, the rejection is rendered moot in view of the above-amendment to claim 1 wherein the subject matter of claim 9 (a claim which is not currently under rejection) is incorporated therein.

Imai et al., U.S. 5,216,074

Claims 1-6 and 9 are rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as

obvious over Imai et al. Applicants respectfully traverse the rejection.

The present invention is drawn to a thermoplastic elastomer composition comprising the following components (A), (B) and (C):

(A) 100 parts by weight of a thermoplastic polyester elastomer;

(B) 3 to 100 parts by weight of a modified olefin resin having an epoxy group or a derivative group thereof in its molecule; and

(C) 10 to 900 parts by weight of a rubbery elastomer selected from the group consisting of an olefin-based thermoplastic elastomers and styrene-based thermoplastic elastomers; wherein the component (C) is not vulcanized; wherein said olefin-based thermoplastic elastomer component (C) is at least one selected from the group consisting of ethylene-propylene copolymer, ethylene-butene copolymer and ethylene-octene copolymer; and wherein said styrene-based thermoplastic elastomer component (C) is at least one selected from the group consisting of styrene-butadiene block copolymer, styrene-isoprene block copolymer, hydrogenated styrene-butadiene block copolymer, and hydrogenated styrene-isoprene block copolymer.

Based upon the advantageous nature of this composition, it can be used as a material for various molding products having excellent

scratch resistance on the surface, flexibility, heat resistance, oil resistance, properties at low temperatures, weatherability, strength and fabrication properties.

We now turn to the disclosure of Imai et al.

Imai et al. teach a thermoplastic elastomer composition comprising component (i) a hydrogenated diene block copolymer in combination with component (ii) at least one of a thermoplastic resin or a rubbery polymer. The Examiner has taken the position that the possible constituents of component (ii) overlap with inventive Components (A), (B) and (C) thereby making the presently claimed invention either anticipated or rendered obvious.

The Examiner relies upon the generic teachings of Elastomer Composition (VIII) as disclosed in column 19, line 6 to column 20, line 26. Also, the Examiner relies upon the specific composition of example 30 as described in Table 6 of Imai et al. In example 30, the Examiner is equating Modiper A4200 with inventive component (B). Also, the Examiner is equating TPEE with the inventive component (A) and the Examiner is equating EPDM with the inventive component (C).

In order to distinguish from Example 30, Applicants have incorporated claim 9 into claim 1. Specifically, the inventive thermoplastic composition no longer contains polymers which could be equated with EPDM as component (C). Applicants respectfully submit that the skilled artisan would not be motivated to modify the

composition of Example 30 of Imai et al. by replacing EPDM with the specific rubbery polymers now defined as inventive component (C).

Applicants respectfully submit that in similar factual situations, the courts have not found the claimed invention obvious. Such a case is In re Baird, 29 USPQ2d 1550 (CAFC, 1994).

In Baird, there was an application claim for a flash fusible toner prepared using a bisphenol A. The Examiner rejected the application claim based upon a reference which taught a genus containing an estimated 100 million different diphenols simply because the reference genus encompassed bisphenol A. The Federal Circuit thought otherwise and overturned the Examiner's rejection.

Important facts which led to the court's conclusion were that the reference cited by the Examiner taught a genus containing a large number of variables and only one of which was bisphenol A. There was nothing in the disclosure of the reference to suggest that one would select the specific variables necessary to obtain bisphenol A. In fact, the specific examples appeared to teach away from the relatively simple formula of bisphenol A, since the specific examples had more complex formulas. The courts reasoned that while the reference may suggest certain complex bisphenol A derivatives, it did not describe or suggest bisphenol A and therefore did not *motivate* the selection of bisphenol A.

In the instant case, the facts are similar. The generically disclosed elastomer composition of Imai et al. encompasses hundreds

of thousands of possible combinations whereas inventive independent claim 1 lists as the rubbery component only ethylene-propylene copolymer, ethylene-butene copolymer and/or ethylene-octene copolymer; and/or styrene-butadiene block copolymer, styrene-isoprene block copolymer, hydrogenated styrene-butadiene block copolymer, and/or hydrogenated styrene-isoprene block copolymer.

Also, the specifically disclosed composition of Example 30 of Imai et al., contains EPDM which is a terpolymer having a diene block. This is in distinction with the possible olefin polymers of inventive Component (C) which are each bipolymers and none of which have a diene block.

A reference must be considered not only for what it expressly teaches but also for what it fairly suggests. In re Burckel, 201 USPQ 67, 70 (CCPA 1979). Given the vast number of combinations encompassed by the generic formula of the thermoplastic composition of Imai et al., and the fact that specifically disclosed Example 30 of Imai et al. contains a rubbery component which is structurally different in many respects from the inventive rubbery component, it is fair to conclude that Imai et al. do not fairly suggest the selection of Components (A), (B) and (C) as encompassed by instant claim 1. Accordingly, a *prima facie* case of obviousness cannot be said to exist and withdrawal of the rejection is respectfully requested.

Allowable Subject Matter

Applicants note with appreciation that the Examiner has indicated that claims 7 and 8 contain allowable subject matter.

Conclusion

In view of the above amendments and comments, Applicants respectfully submit that the claims are in condition for allowance. A notice to such effect is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Garth M. Dahlen, PhD. (43,575) at the telephone number of the undersigned below.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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